



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 1, 4, 8, 11, and 12 of the morning section and questions 12 and 26 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On August 5, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional two points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning questions 1,4, and 8 and afternoon questions 12 and 26. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

1. The model answer: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for,” (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

Petitioner argues that answer (E) is correct. Petitioner contends that all of the responses are subject to proper interpretation under 35 U.S.C. § 112, paragraph 6.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that all of the responses are subject to proper interpretation under 35 U.S.C. § 112, paragraph 6, the question asks which is the best way so that it will be so interpreted. Selections (A), (B) and (D) contain limitations that direct the examiner to construe the claim according to its specific language without regard to the sixth paragraph. Whether the examiner may construe the claim under the sixth paragraph after an argument is not within the scope of the question. Only selection (C) meets the requirements of MPEP § 2181. Accordingly, model answer (C) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 4 reads as follows:

4. The specification in your client’s patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation- in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

4. The model answer: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

Petitioner argues that answer (C) is also correct. Petitioner contends that an objection to new matter cannot be overcome in a single application, and filing a continuation-in-part merely allows the original application to die.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that an objection to new matter cannot be overcome in a single application, and filing a continuation-in-part merely allows the original application to die, the question does not restrict the overcoming to a single application. The objection will, in fact, be overcome in the continuation-in-part. Accordingly, model answer (B) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones

patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

- (A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.
- (B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.
- (C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.
- (D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).
- (E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). ~~Also, evidence or common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (B) is also correct. Petitioner contends that the facts do not indicate what paragraph of 35 USC 102 is applied in connection with 35 USC 103 and selection (B) fails to indicate which date is antedated.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the facts do not indicate what paragraph of 35 USC 102 is applied in connection with 35 USC 103 and selection (B) fails to indicate which date is antedated, the fact pattern clearly states that the rejection is based on 35 USC 103 rather than 35 USC 102 and that selection (B) includes antedating the reference, whatever

the actual date may be. To the extent the petitioner is arguing the actual date might be such that the reference is not antedated in (B), the phrasing of (B) is clearly in opposition to such an argument. To the extent the petitioner is arguing that the examiner may not have known that the art was a 35 USC 102(a) type reference for the purpose of overcoming a common assignee argument, the facts clearly indicate that the reference is a 35 USC 102(a) type reference, and there is no need to assume that an examiner would not recognize that. In any event, the burden is on the applicant to overcome the 35 USC 103 rejection, and that cannot be done in selection (D), making selection (D) the best answer. Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

(A) Barry's device is too large to combine with Lance's device.

(B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.

(C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.

(D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.

(E) All of the above.

12. The model answer: (C) is correct. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance's device unsatisfactory for its intended purpose. (A) is incorrect. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of

ordinary skill in the art. (B) is incorrect. “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry’s art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that the question is vague and answers (A), (B) and (C) “could work under the right circumstances.”

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that (B) could be the correct answer, test takers are supposed to pick the best answer. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. Answer (C) is the correct because an argument that the combination of references would have precluded Lance’s device from performing as Lance intended could properly overcome a 103 rejection. An argument that the Barry reference is nonanalogous art, because it relates to a different field of endeavor that the applicant’s invention would not overcome a 103 rejection because that only satisfies part of the test as to whether the reference is nonanalogous art. The test for whether a reference in nonanalogous art has nothing to do with whether the Barry reference is “reasonably pertinent” or “pertinent” to primary reference (which is Lance in this question). In addition, the instructions specifically warn test takers not to assume any additional facts, which is what petitioner has done in making the case that answer (A), (B) and (C) could be correct answers. Accordingly, model answer (C) is the most correct answer, and petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 26 reads as follows:

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent (“P1”), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The

examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles ("P2"), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision. On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you've never heard of, and he wants to "revive his patents." He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption "It's just a dream: it can't be made we've tried a thousand times, don't bother." He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. "But it's such a stupid way to do things - it's expensive and it doesn't work very well- it doesn't even make a safety candle," Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing Annie's proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash's patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

- (A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.
- (B) File a request for reexamination of P1 based on the Wicks and Sticks article.
- (C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.
- (D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.
- (E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

26. The model answer: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article "shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*" (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that

were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because a request for reexamination cannot be based on a video tape ~~broadened claims may not be filed in a reexamination~~. (E) is not the best answer because it is not clear there is an “error” under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

Petitioner argues that answer (E) is correct. Petitioner also argues that answer (B) is incorrect, and therefore, credit should be given for all answers. Petitioner contends that the fact pattern fails to show a substantial new question of patentability and that the question does not ask for the best answer.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the fact pattern fails to show a substantial new question of patentability and that the question does not ask for the best answer, under the facts as stated, the Wicks and Sticks article “shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*” (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. As to the issue of substantiality of the patentability issue, whether the issue of patentability is substantial is determined by the Office, not the party filing the reexamination request. 35 USC 303, 304. The provisions of 35 USC 302 clearly allow for a reexamination request to be filed in this fact pattern. It is also noted that the directions on the front of the exam specifically state that the most correct answer is to be selected. Following the procedure in answer (E) would not be the best answer for the question because there is no clear error as a basis for reissue in that videotape is not prior art against the process claims and the failure to claim the reflective housing is not a clear basis for reissue. Accordingly, model answer (B) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy